



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,198	12/27/2000	Alain Marbach	SAA-63	9529
23569	7590	12/15/2004	EXAMINER	
			SNAPP, SANDRA S	
		ART UNIT		PAPER NUMBER
				3624

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/749,198	MARBACH ET AL. <i>MW</i>	
<b>Examiner</b>		<b>Art Unit</b>	3624
Sandra Snapp			

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 March 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-45 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-45 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 27 December 2000 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1-19-01</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 1-19-01 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. Some of the information on the IDS has been marked through because it is redundant, and if allowed to remain on the IDS would be printed on the face of the patent in duplicate. However the relevant parts have been considered.

Also, the Brazilai, et al. patent (6,021,045) has not been considered because patent number 6,021,045 is for a patent issued to Johnson for a Heat Sink. It appears there may be an error in the application number or the spelling of the inventors last name. If the applicant would submit a new copy of the reference, the Examiner will consider it timely and review it.

### ***Claim Objections***

Claim 45 is objected to because the claim is redundant with claim 30, from which it depends. Does the Applicant really intend for claim 45 to depend from claim 31 instead of claim 30? Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 28 and 31-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13, 28 and 43 are indefinite because it is unclear what is meant by “blindly notifying the winning bidder.” Clarification is required.

Claims 31-44 are indefinite because they are directed to a “system” however it is unclear from the claim language whether the system is actually intended to be a method or an apparatus. Clarification is required.

#### ***Claim Rejections - 35 USC § 101***

Claims 1-15 and 31-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-15 and 31-44 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning. The Examiner suggests amending the claims to include some language directed to a computer in the body of the claims to overcome this rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Godin et al. patent (US 5,890,138) in view of the E-Licensing article supplied by the Applicant.

The Godin reference discloses a method, computer readable medium and system comprised of the steps of:

Sending a bidder a bid form for an intellectual property auction for auctioning intellectual property of an intellectual property owner, the bid form prompting the bidder to enter bid information including registration information identifying the bidder, license type information, and bid amount information (col. 4, lines 16-52),

Receiving from the bidder bid information comprising registration information, license type information, and bid amount information (col. 4, lines 16-52), and

Sending to the owner of the intellectual property the license type information and the bid amount information, while withholding from the intellectual property owner the registration information until at least the conclusion of the auction (col. 6, lines 56-58) (Claims 1, 16 and 31);

Sending the bid information in at least a facsimile, html page, or regular mail (col. 7, lines 31-34) (Claims 2, 17 and 32);

Checking for duplicate bidders and storing the bid information (col. 7, lines 45-55), and

Validating and registering the bidder (col. 7, lines 55-60 and col. 4, lines 41-52) (Claims 3, 18 and 33);

Checking the registration information for a minimum required amount of registration information, the minimum required information including at least one of a password, name, company, street, city, state, postal code, phone number, fax number, and a working electronic mail address (Fig. 11) (Claims 5, 20 and 35);

Creating a unique registration number from the minimum required registration information (col. 4, lines 41-52),

Storing the minimum amount of registration information in a registration file (col. 4, lines 41-52), and

Indexing the registration information based upon the unique registration number (col. 4, lines 41-52, indexing is inherent in a system that stores, as there must be some form of index from which to retrieve the objects from storage) (Claims 6, 21 and 36);

Creating a bid number for the bid of the unique registration number (col. 6, line 58 through col. 7, line 21),

Storing the bid information (col. 7, lines 1-21),

Verifying the bid information based upon the license type information () and

Validating the bid amount information () (Claims 7, 22 and 37);

Checking the received bid amount information against a stored bid amount information (col. 1, lines 43-55),

Rejecting the received bid amount, if any of the received bid amount information is a lower amount than any of the stored bid amount information (col. 1, lines 43-55),

Storing the non-rejected validated bid amount information in a bid analysis file system

(col. 4, lines 41-52), and

Indexing the bid amount information based upon the bid number (col. 4, lines 41-52, indexing is inherent) (Claims 12, 27 and 42);

Selecting the bidder as the winning bidder (col. 7, lines 31-33), and

Blindly notifying the winning bidder, unless a standard license change, based upon the registration number indexed with the bid number (col. 7, lines 31-33) (Claims 13, 28 and 43);

Receiving from the winning bidder a confirming message including information identifying the winning bidder (col. 6, lines 55-67) (Claims 14, 29 and 44); and

Determining whether the bid is a winning bid (col. 6, lines 56-60), and

Deleting the bid if it is not a winning bid (col. 6, lines 56-60) (Claims 15, 30 and 45).

The Godin patent lacks:

The bid information that is entered including information identifying the license type information (Claims 1, 16 and 31);

Receiving a signed license from the bidder to validate the bidder (Claims 4, 19 and 34);

Verifying the bid information based upon the license type information (Claims 7, 22 and 37);

Checking the license type information for a minimum required amount of license type information, the minimum required amount of license type information comprising a license right type, business use type, and an intellectual property use type (Claims 8, 23 and 38);

Verifying the bid amount information for the minimum required amount of bid amount information, the minimum required amount of bid amount information comprising at least one of a seat rate, a minimum royalty rate, a paid-up rate, an assignment rate, and an up-charge rate, further selected by the license type information (Claims 9, 24 and 39);

Checking the intellectual property right type information for a minimum required amount of intellectual property use type information comprising at least one of a patent license, a patent claim license, a copyright license, software license and trademark license, further selected by a right to use, a right to make, and a right to exclude (Claims 10, 25 and 40);

Validating the received bid amount information based upon a predetermined bid amount information comprising at least one of a seat rate, a minimum royalty rate, a paid-up rate, an assignment rate, and an up-charge rate, by rejecting the received bid amount information that does not compile with the predetermined bid amount information (Claims 11, 26 and 41);

Evaluating the sent bid amount information and license type information (claims 13, 28 and 43); and

Sending to the winning bidder the legal documents associated with the license type information (Claims 14, 29 and 44).

The E-commerce article teaches:

The bid information that is entered including information identifying the license type information (col. 1) (Claims 1, 16 and 31);

Verifying the bid information based upon the license type information (col. 2) (Claims 7, 22 and 37);

Checking the license type information for a minimum required amount of license type information, the minimum required amount of license type information comprising a license right type, business use type, and an intellectual property use type (col. 1) (Claims 8, 23 and 38);

Verifying the bid amount information for the minimum required amount of bid amount information, the minimum required amount of bid amount information comprising at least one of a seat rate, a minimum royalty rate, a paid-up rate, an assignment rate, and an up-charge rate, further selected by the license type information (col. 1) (Claims 9, 24 and 39);

Checking the intellectual property right type information for a minimum required amount of intellectual property use type information comprising at least one of a patent license, a patent claim license, a copyright license, software license and trademark license, further selected by a right to use, a right to make, and a right to exclude (col. 1) (Claims 10, 25 and 40);

Validating the received bid amount information based upon a predetermined bid amount information comprising at least one of a seat rate, a minimum royalty rate, a paid-up rate, an assignment rate, and an up-charge rate, by rejecting the received bid amount information that does not compile with the predetermined bid amount information (col. 1) (Claims 11, 26 and 41); and

Evaluating the sent bid amount information and license type information (col. 1) (claims 13, 28 and 43) (Claims 14, 29 and 44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Godin system to include the teachings of the E-commerce article so as to expand the auction to be available to more, varied users in other types of products and

service. Also to provide owners of intellectual property with an easy, fast, streamline, user-friendly mechanism for licensing their property to others.

The Godin patent also lacks:

Receiving a signed license from the bidder to validate the bidder (Claims 4, 19 and 34);

and

Sending to the winning bidder the legal documents associated with the license type information (Claims 14, 29 and 44).

However, the Examiner takes Official Notice that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Godin/E-commerce article combination to include receiving a signed license from the bidder to validate the bidder (Claims 4, 19 and 34); and sending to the winning bidder the legal documents associated with the license type information (Claims 14, 29 and 44) because it is common knowledge that before licensing transactions can be complete, the license must be signed and forwarded to the other party.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Goino, Conklin, Ausubel, Woolston, Huberman, Sick, Moderegger, Yokota, Elliott, Wilkinson, Tran and Kossovsky references are all directed to various types of electronic auction systems.

Art Unit: 3624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ss

*Sandra Snapp*  
SANDRA S. SNAPP  
PATENT EXAMINER  
GROUP 3600